

REMARKS

Claims 1, 2, 4-7 and 9 are pending in the above application. By the above amendment, claims 3, 8 and 10 have been cancelled.

The Office Action dated June 14, 2005, has been received and carefully reviewed. In that Office Action, claims 1-10 were rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-33 of U.S. 6,542,161 in view of Hitchcock and further in view of "Applicant Admitted Prior Art (AAPA)." Reconsideration of this rejection is respectfully requested in view of the following remarks.

PREMATURE FINALITY

As an initial matter, it is respectfully submitted that the finality of the present Office Action is premature and should therefore be withdrawn. Applicant did not amend any claim in response to the previous Office Action; however, a new rejection has been raised in this Office Action and the new rejection has been made final. Through no fault of Applicant, the examiner has changed the rejection without providing Applicant with a chance to address the new rejection. Specifically, the original double patenting rejection was improperly based on a device disclosed in a prior art reference rather than on a claim. ("It would have been obvious ... to utilized [sic] the bit map character representation as taught by Hitchcock into the device of Patent 161' because..."). The new rejection recites that "it would have been obvious ... to utilize the bit map character representation as taught by Hitchcock into the device **disclosed in claim 1** of Patent 161' because...." (emphasis in original). It is respectfully submitted that Applicant should be given the opportunity to respond to this new ground of rejection.

The present Office Action argues that "the device of Patent 161' means the device discloses [sic] by claim 1." However, the meaning of the first Office Action was clear. Applicant should not be required to guess at the subjective intent of an examiner in making a rejection; Applicant can only address the rejections that are made. Applicant argues against the propriety of this new rejection below. However, there was no reason for the applicant to provide these arguments in response to the prior Office Action. It is therefore respectfully requested that the finality of the present Office Action be withdrawn and that claims 1, 2, 4-7 and 9 be allowed.

If the rejection of any claims is maintained, it is respectfully requested that a new Office Action be issued in which the basis for the rejection is explained, a motivation for combining references is provided, and Applicant's arguments presented below are clearly addressed.

DOUBLE PATENTING

A Motivation for Combining and Modifying References Has Not Been Provided

It is respectfully submitted that no motivation for modifying claim 1 of the '161 patent has been provided and that therefore a *prima facie* case of obviousness type double patenting has not been presented. The alleged motivation for combining references is that "it would improve character positioning through the use of sub-pixel precision without formatting of existing documents." To the extent this statement can be understood, it appears to state a result that would allegedly occur if the combination were made. It in no manner suggests a motivation or reason for making the combination in the first place. Nothing in pending claim 1 suggests a need for improved character positioning. Nothing in Hitchcock suggests anything about a claimed second bit map which represents a basic portion of an italic character. As provided in the MPEP, the fact that a reference can be modified does not provide motivation for making the combination. MPEP 2143.01. Therefore, even if Hitchcock can somehow be combined with claim 1 of the '161 patent, no motivation for making such a combination has been presented.

The motivation for the next step in the proposed modification of claim 1 of the '161 patent is even more difficult to determine. It appears to be that, because italic characters are known and sometimes used for emphasis, it would be obvious to make certain additional changes to claim 1 of the '161 patent. The "motivation" is that this "would allow users to actually see an improving emphasized display characters by the italic characters on the screen." Again, this appears to be an alleged result of some combination of references and not a motivation or reason to make a modification in the first place. No motivation for combining references and modifying claim 1 of the '161 patent has been provided. It is therefore respectfully submitted that a *prima facie* case of obviousness has not been presented and that claim 1 of the present application is allowable over the art of record.

Claim 2 includes limitations directed to a control section that acquires a first bit map which represents a basic portion of a character and performs a predetermined conversion of the first bit map so as to generate a second bit map which represents a basic portion of an italic character. Claim 2 is therefore submitted to be allowable for at least the same reasons as claim 1.

Claim 5 requires a character display method that includes steps of acquiring a first bit map which represents a basic portion of a character and performing predetermined conversion on the first bit map so as to generate a second bit map which represents a basic portion of an italic character. Claim 5 is therefore submitted to be allowable for at least the same reasons as claim 1.

Claim 6 requires a recording medium storing a program that allows a control section of a display device to perform steps including acquiring a first bit map which represents a basic portion of a character and performing predetermined conversion on the first bit map so as to generate a second bit map which represents a basic portion of an italic character. Claim 6 is therefore submitted to be allowable for at least the same reasons as claim 5.

Claim 7 requires character display methods, each of which includes the steps of acquiring a first bit map which represents a basic portion of a character and performing predetermined conversion on the first bit map so as to generate a second bit map which represents a basic portion of an italic character. Claim 7 is therefore submitted to be allowable for at least the same reasons as claim 1.

Claim 9 requires a recording medium storing a program that allows a control section of a display device to perform steps including acquiring a first bit map which represents a basic portion of a character and performing predetermined conversion on the first bit map so as to generate a second bit map which represents a basic portion of an italic character. Claim 9 is therefore submitted to be allowable for at least the same reasons as claim 6.

The Proposed Combination Does Not Result in the Claimed Invention

The Office Action indicates that “it would have been obvious to utilize the bit map character representation as taught by Hitchcock into the device disclosed in claim 1 of Patent 161’...” The meaning of this statement is not clear. Hitchcock represents characters with

bitmaps and discusses character width and spacing. However, it is not clear what "bit map characterization" of Hitchcock is referred to and how this bitmap characterization suggests a modification to claim 1 of the '161 patent. Moreover, every scaling performed by Hitchcock is performed on the entire character – therefore Hitchcock in no manner suggests changing a character into an italic character. Italic characters are known, but it is not clear how the existence of italic characters fits in with Hitchcock's teachings or suggests a first bit map which represents a basic portion of a character and performs predetermined conversion of the first bit map so as to generate a second bit map which represents a basic portion of an italic character as required by claim 1.

In view of the above, it is respectfully submitted that the claims were in condition for allowance before the entry of the above amendment. However, in order to advance the prosecution of this application, claim amendments are being made to further define over the art of record. By the above amendment, claim 1 has been amended to require the second bit map is generated from the first bit map by shifting each dot forming the first bit map by a shift amount which is in proportion to a distance from a reference line running along the predetermined direction set in the first bit map to a dot. This feature is not shown or suggested by the art of record, and claim 1 is submitted to further distinguish over the references for this reason.

Claims 2, 4-7 and 9 have also been amended to include the above limitation and are therefore submitted to be allowable for at least the same reasons as claim 1.

In view of the above, it is respectfully submitted that 1) a proper motivation for combining references has not been provided and 2) even if the references could somehow be combined, the result would not be the invention defined the claims pending in the present application. Reconsideration and allowance of claims 1, 2, 4-7 and 9 is therefore earnestly solicited.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750)

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at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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